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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,993	12/22/1999	SHERYL BEHAR	003184/0006	5639

31013 7590 03/08/2005

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
919 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/469,993

Applicant(s)

BEHAR ET AL.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,11,13-17,19-22,27,30,32-36,38 and 39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3,8,11,13-17,19-22,27,30,32-36,38 and 39 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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NON-FINAL REJECTION (PAPER # 26)

DRAWING OBJECTIONS

1. This application has been filed with drawings that are objected to by the PTO draftsman. See Form PTO 948.

NEW CLAIM REJECTIONS — 35 U.S.C. §102(b)

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 8, 11, 13-17, 19-22, 27, 30, 32-36 & 38-39 are rejected under 35 U.S.C. §102(b) as being anticipated by Walker US 6,018,718 (Jan. 25, 2000) [US f/d: Aug. 28, 1997] (herein referred to as "Walker").

As per claim 1, Walker (FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; col. 1, ll. 37-47; col. 2, ll. 10-67; col. 4, ll. 8-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-45) shows "A computerized system for implementing a credit card program rewarding use of a credit card by the credit card holder, comprising: a credit card issued by an issuer to a holder,

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said credit card representing an available line of credit from said issuer for said holder and providing means for said issuer to settle one or more credit card transactions of said holder, a data-processing computer, said computer including a database, said database storing a holder ID and a current balance associated with said holder, said current balance including a sum of all said credit card transactions and any finance or other charges minus any payments by said holder to said issuer and any refunds or other credits, means associated with said computer for determining whether at least one of said credit card transactions made by said holder complies with a set of pre-defined program rules, said pre-defined program rules permitting the purchase using said credit card of at least one of goods and services of any provider of goods or services regardless of whether there is a co-branding relationship between said issuer and said provider associated with said credit card, a rebate tally for said holder stored in said database, said rebate tally representing rebate credits earned by said holder based on ones of said credit card transactions that comply with said pre-defined program rules less any rebate payments paid by said issuer to said holder, said rebate tally being automatically updated in said database in response to said ones of said credit card transactions that comply with said pre-defined program rules without notice from said holder and said provider, and a rebate payment from said issuer to said holder based on said rebate tally and being provided without affecting any point-of-sale credit card transaction of said holder, said rebate payment being unrestricted by said issuer and said provider as to use by said holder.” Therefore, Walker discloses

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the inventive concept of the claimed invention recited in claim 1, and the elements of the instant claim read on the disclosure of Walker cited above.

Dependent claim 2 is rejected for at least the same reasons as recited in the rejection of independent claim 1.

Dependent claim 3 is rejected for at least the same reasons as recited in the rejection of independent claim 1.

As per claim 8, Walker shows the system of claim 1.

Walker (FIG. 4) shows “The computerized system of claim 1, wherein the application of said rebate credits to said rebate payment is capped at a maximum amount incurred in a preselected period of time. Therefore, Walker discloses the inventive concept of the claimed invention recited in claim 8, and the elements of the instant claim read on the disclosure of Walker cited above.

As per claim 11, Walker shows the system of claim 1.

Walker (FIG. 4) shows “The computerized system of claim 1, wherein said one or more credit card transactions include purchase transactions, and said rebate payment is one of . . . a fixed amount and . . . a percentage of said ones of said credit card purchase

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transactions that comply with said pre-defined program rules.” Therefore, Walker discloses the inventive concept of the claimed invention recited in claim 11, and the elements of the instant claim read on the disclosure of Walker cited above.

As per claim 13, Walker shows the system of claim 1.

Walker (col. 7, ll. 60-67; and col. 7, ll. 50-60) shows “one or more credit card transactions include at least one of cash advances made to said holder from said issuer and transfers of credit balances of said holder to said current balance, said rebate tally including at least a portion of said at least one of cash advances made to said holder from said issuer and transfers of credit balances of said holder to said current balance.” Therefore, Walker discloses the inventive concept of the claimed invention recited in claim 13, and the elements of the instant claim read on the disclosure of Walker cited above.

As per claim 14, Walker shows the system of claim 1.

Walker (FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; col. 1, ll. 37-47; col. 2, ll. 10-67; col. 4, ll. 8-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-45) inherently shows “one or more credit card transactions include purchases transactions, and said credit card purchase transactions include at least one purchasing and leasing a particular type of

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goods from any manufacturer of said particular type of goods to comply with said pre-defined program rules.” Said leasing would have been inherent in the disclosure of Walker because “leasing” and/or renting were well known means of obtaining control of products or services using credit cards at the time of the invention. Therefore, Walker inherently discloses the inventive concept of the claimed invention recited in claim 14, and the elements of the instant claim read on the disclosure of Walker cited above.

Dependent claim 15 is rejected for at least the same reasons as recited in the rejection of dependent claim 14.

Dependent claim 16 is rejected for at least the same reasons as recited in the rejection of dependent claim 15.

As per claim 17, Walker shows the system of claim 1.

Walker (FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; col. 1, ll. 37-47; col. 2, ll. 10-67; col. 4, ll. 8-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-45) inherently shows “a second credit card issued by said issuer to a second holder to effect one or more credit card transactions, said credit card transactions of said second holder being added to said rebate tally.” Said second credit card implementation would have been inherent in the

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disclosure of Walker because providing additional credit cards to a spouse or other family member was well known means of increasing the purchasing of individuals in given households at the time of the invention. Therefore, Walker inherently discloses the inventive concept of the claimed invention recited in claim 17, and the elements of the instant claim read on the disclosure of Walker cited above.

As per claim 19, Walker shows the system of claim 1.

Walker (FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; col. 1, ll. 37-47; col. 2, ll. 10-67; col. 4, ll. 8-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; and col. 11, ll. 1-45) inherently shows “said rebate . . . is in the form of at least one of a check forwarded to said holder from said issuer and a credit to said current balance of said holder.” Said check issuing implementation would have been inherent in the disclosure of Walker because providing rewards to a participant via check was a well known means of rewarding purchasers. Therefore, Walker inherently discloses the inventive concept of the claimed invention recited in claim 19, and the elements of the instant claim read on the disclosure of Walker cited above.

Claim 20 is rejected for the same reasons as claim 1.

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Claim 21 is rejected for the same reasons as claim 2.

Claim 22 is rejected for the same reasons as claim 3.

Claim 27 is rejected for the same reasons as claim 8.

Claim 30 is rejected for the same reasons as claim 11.

Claim 32 is rejected for the same reasons as claim 13.

Claim 33 is rejected for the same reasons as claim 14.

Claim 34 is rejected for the same reasons as claim 15.

Claim 35 is rejected for the same reasons as claim 16.

Claim 36 is rejected for the same reasons as claim 17.

Claim 38 is rejected for the same reasons as claim 19.

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Claim 39 is rejected for at least substantially the same reasons as claim 20.

PRIOR ART NOT RELIED UPON

Peter Lucas, "Discover's new chemistry"; *Credit Card Management*; Mar 1996; 8,12; pp. 51-52, 54-56.

Lisa Fickenscher, "Discover Unit Sues Amex, claiming Infringement on 'Cash Back' Trademark; American Banker, New York, N.Y.: Dec 1, 1998, Vol. 163, Iss. 228; pg 15.

Humberto Cruz, "AMOUNT CHARGED IS KEY TO CREDIT CARD REBATE DEALS"; Sun Sentinel. Fort Lauderdale: Sep 24, 1997, pg. 3.D.

RESPONSE TO ARGUMENTS

3. Applicant's response/arguments (paper#24, filed 12/31/2003) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons: Applicant's arguments are moot based on new grounds of rejection.

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

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P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED

PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801 or (571) 272-6725. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469 or (571) 272-6724.

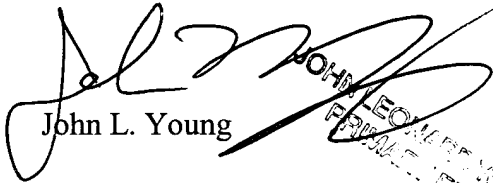
Serial Number: 09/469,993

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young
Primary Patent Examiner
March 4, 2005

*JOHN L. YOUNG, ESQ.
PRIMARY EXAMINER*